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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/833,620      04/07/97      DOBBINS

M      15275/8610 (D)

EXAMINER

IM62/0529

MICHAEL L GOLDMAN  
NIXON PEABODY LLP  
CLINTON SQUARE, P.O. BOX 31051  
ROCHESTER NY 14603

HOEFMANN, J

ART UNIT

PAPER NUMBER

1731

DATE MAILED:

05/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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36

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 5-14-01
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 12, 13, 22, 33-53 is/are pending in the application.
- ☐ Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 12, 13, 22, 33-53 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-42, 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's supplied translation of Kawaguchi JP 138145 (hereinafter referred to as '145) in view of Schwarz EP 38900.

Claims 39-42 and 49-52 are the same as 1, 4-6, 23, 26-27, and 30 (respectively) were at the time they were cancelled. Thus they are rejected for the reasons claims 1, 4-6, 23, 26-27, and 30 were previously rejected. Further, it would have been obvious to use the Schwarz starting material, for the advantages given at page 3, lines 7-9 of Schwarz.

Claims 43, 45-46, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Carpenter, '145 and Schwarz.

Claims 43, 45-46 and 48 are the same as 7, 11, 17, and 21 (respectively) were at the time they were cancelled. Thus they are rejected for the reasons claims 7, 11, 17, and 21 were

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previously rejected. Further, it would have been obvious to use the Schwarz starting material, for the advantages given at page 3, lines 7-9 of Schwarz.

Claims 12, 13 and 22 and 33-38 and 43, <sup>44</sup>53, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller 4501602 in view of Schwarz EP0038900 and optionally in view of Hyde 2272342 and/or JP 138145 ('145).

See the previous Office action for the manner in which the art is applied.

New claims <sup>44</sup>43, 53, 46 and 47 are also met under the combination of prior art.

Applicant was correct in noting that claims 33-38 were inadvertently left off of the list of the claims in the previous rejection - but that the body of the rejection gives notice that the Office deemed the claims obvious.

### ***Response to Arguments***

Applicant's arguments filed 14 May 2001 have been fully considered but they are not persuasive.

It is argued that there is no suggestion in Schwarz to use the silicic acid dispersion to build up and form a deposit on the support. This is true but not relevant; the rejection makes no mention of using a dispersion to perform the method.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to the arguments regarding the prima facie combination of Schwarz. As indicated above - Schwarz provide motivation for using the siloxane at page 3, lines 7-9.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

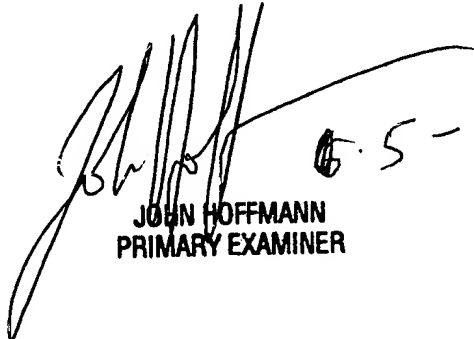
## Requests for interviews

The Office initiates interviews whenever it is deemed that it would be beneficial to do so to advance prosecution. And when an Applicant wishes to have an interview, the burden to initiate the interview remains solely with Applicant. MPEP 408 notes that Examiners are not required to note or acknowledge requests for telephone calls or state reasons why such proposed telephone interview would not be effective; therefore, requests for the Office to initiate interviews will not be acknowledge.

MPEP 713.05, 713.03, 713.09, and 713.01 and common sense indicate that any of the following questions would be appropriate for the Office to ask prior to granting an interview: Has there already been an interview of record in the case? Will the interview last more than 30 minutes? When do you want the interview? Does Applicant's representative have Power of Attorney? Does Applicant's representative have authority to bind the principal concerned? ( i.e. Does Applicant's representative have authority to make any and all changes?) Who will participate in the interview? What is the intended purpose(s) of the interview? What is the intended content of the requested interview? Failure to volunteer the above information might possibly result in a denial of an interview, or the inability of the Examiner to adequately answer Applicant's questions during the interview.

## CONTACT INFORMATION

Examiner's number	(703) 308-0469
fax- official papers after a final rejection	305-3599
fax- official papers (all others)	305-7718
fax- unofficial papers	305-7115
Group Receptionist	308-0651

  
6.5-25-01  
JOHN HOFFMANN  
PRIMARY EXAMINER